

REMARKS

Claims 1, 2, 4, 5, 8, 10, 12-14, 18-22, 31 and 36 are pending. No new matter is added in this Response.

1. Claims 1, 2, 4, 5, 14, 19, 20 and 22

The Office Action rejected claims 1, 2, 4, 5, 14, 19, 20 and 22 under 35 U.S.C. § 103(a) over *Henmi et al.* in view of *Sheu et al.* However, in order to render a claim obvious, the cited references must suggest each and every limitation of the claim. *See* MPEP § 2143. The combination of *Henmi et al.* in view of *Sheu et al.* fails to teach all elements of those claims, and thus the combination fails to render any of the claims obvious.

Claims 1, 2, 4, 5, 14, 19, 20 and 22 are directed to a method that includes “setting the angle between the grinding wheel rotational axis and roll rotational axis less than about 25 degrees.” Each of these claims also requires “maintaining a ratio of axial taper tolerance (TT) to radial wheel wear compensation (WWC) of greater than 10” **The Office Action fails to state where in *Henmi et al.* these limitations are taught, and the reference in fact contains no such teaching.**

The Office states that *Henmi et al.* discloses a method of grinding a ferrous wheel roll...the method comprises the claimed method steps that include: mounting the wheel on a machine spindle and setting the angle between the grinding wheel rotational axis and roll rotational axis less than about 25 degrees; and bringing the rotating wheel into contact with a rotating roll surface and traversing the wheel across an axial roll length, while maintaining a ratio

of axial taper tolerance to radial wheel wear compensation of greater than 25; and prohibiting thermal degradation.

To find a claim obvious, the Patent Office must make “a searching comparison of the claimed invention – including all its limitations – with the teachings of the prior art.” *In re Ochai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added); see also *In re Wada and Murphy*, Appeal No. 2007.3733 (BPAI Jan. 18, 2008) (obviousness rejection reversed when the Examiner did not explain where or why the cited references disclosed a particular claim limitation). **Here, the Office Action does not explain where any of the references teach the limitations above, and the references contain no such teachings.**

The Office further states that it would have been obvious to one having ordinary skill in the art at the time that invention was made to have ground *Henmi*’s roll to a surface finish less than 3 micrometers as taught by *Sheu et al.* so as to achieve a polished finish.

As discussed above, *Henmi et al.* fails to teach or suggest all Applicants’ claim limitations as required by MPEP §2143. The combination of *Henmi et al.* in view of *Sheu et al.* fails to teach all elements of those claims, and thus the combination fails to render any of the claims obvious.

Applicants respectfully submit that the 35 U.S.C. §103(a) rejection is improper and Applicants respectfully request withdrawal of the rejections of claims 1, 1, 2, 4, 5, 14, 19, 20 and 22.

2. Claims 8, 10, 12, 13, 18 and 21, 31, and 36

Claims 8, 10, 12, 13, 18 and 21, 31, and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Henmi et al.* in view of *Sheu et al.* and in further view of *Mori et al.* (6,306,007). However, in order to render a claim obvious, the cited references must suggest each and every limitation of the claim. *See* MPEP § 2143.

As discussed above, the Office Action fails to state where in *Henmi et al.* the limitations are taught as required by MPEP § 2143. The combination of *Henmi et al.* in view of *Sheu et al.* and in further view of *Mori et al.* fails to teach all elements of those claims, and thus the combination fails to render any of the claims obvious.

Applicants respectfully submit that the 35 U.S.C. §103(a) rejection is improper and Applicants respectfully request withdrawal of the rejections of claims 8, 10, 12, 13, 18, 21, 31 and 36.

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CONCLUSION

Based on the arguments presented above, Applicants request withdrawal of the rejections and allowance of all claims. If the Examiner has any questions or comments or needs any additional information, I invite the Examiner to telephone me at the number listed below.

Respectfully submitted,

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